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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/621,085
Filing Date: July 15, 2003
Appellant(s): MORTENSEN ET AL.

Samuel M. Freund
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/28/2008 appealing from the Office action mailed 05/14/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,088,796	CIANFROCCA	7-2000
6,922,701	ANANIAN	8-2000
2006/0005126	SHAPIRO	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cianfrocca et al. (Cianfrocca hereinafter) (US Patent No. 6,088,796), in view of Ananian et al (Ananian hereinafter) (US Patent No. 6,922,701 B1), and further in view of Shapiro (US Patent App. Pub. No. 2006/0005126 A1, filed: October 7, 2002).

Regarding Claim 1, Cianfrocca discloses a method of managing data in a plurality of disparate and diverse databases (Fig. 1, items 105, and 106, Col. 6, lines 11 – 20, Cianfrocca) comprising:

providing a first database located in a first location (Fig. 1, item 105, Col. 6, lines 11 – 14, Cianfrocca) and further being located behind a first firewall (Fig. 1, item 104, Col. 6, lines 13 – 14, Cianfrocca);

providing a second database located in a second location (Fig. 1, item 106, Col. 6, lines 14 – 17, Cianfrocca) and further being located behind a second firewall (Fig. 1, item 104, lines 14 – 17, Cianfrocca);

providing a clearinghouse server (Fig. 1 and 4, item 103, Web Server Running Messenger System, Col. 6 and 17, lines 17 – 20 and 1 – 2; respectively, Cianfrocca) located outside of said first firewall and said second firewall (Fig. 1, item 104, Firewall, Col. 6, lines 19 – 22, Cianfrocca), said clearinghouse server having a clearinghouse database (Fig. 4, Col. 17, line 54, Database, Cianfrocca);

providing a workstation located behind said first firewall (Col. 16, lines 24 – 28, Cianfrocca¹), said workstation having a clearinghouse interface program (Col. 16, lines 27 – 28, clients, Cianfrocca²);

establishing communications between said clearinghouse interface program with said clearinghouse server (Col. 16, lines 24 – 26, Cianfrocca).

Cianfrocca does not explicitly teach indexing CAD data from the databases, transmitting request for a requested file, determining the location of said requested file, sending a request to second database for said file, converting said file to transmittable format, or transmitting said file. On the other hand, Ananian discloses a method and system for managing CAD data files (Col. 2, lines 43 – 47, Ananian), including: a clearinghouse database comprising an index to at least a portion of CAD data in first database and at least a portion of CAD data in second database (Fig. 1, Col. 9 and Col. 11, lines 19 – 23 and 4 – 8; respectively, Ananian); transmitting a request for a requested file from said clearinghouse interface program to said clearinghouse server (Col. 13, lines 14 – 30, Ananian); determining that said requested file is located in said second database by using said clearinghouse database (Col. 14, lines 2 – 4, Ananian³); sending a request from said clearinghouse server to said second database for said

¹ Cianfrocca discloses, as cited above, workstations including programs, in the User Agent, to communicate with the messenger system server (equivalent to the clearinghouse server). In addition, Cianfrocca discloses that the communication between the User Agent and messenger system server will be across firewall (Col. 8, lines 7 – 9). This implies that the workstations are also behind the firewall.

² Cianfrocca discloses that clients will be programs that run at user workstations and call routines to connect to the messenger system server (equivalent to the clearinghouse server).

³ Ananian further discloses entering zip code or country (location) and other topics of the specific item requested. This implies locating the requested item in a specific database (see Col. 14, Table 1, lines 23 and 27).

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requested file (Col. 14, lines 35 – 38, Ananian); converting said requested file to a first transmittable format (Col. 3 and 7, lines 37 – 39, and 21 – 27 and 48 – 53; respectively, Ananian⁴). It would have been obvious to one of ordinary skills in the art at the time the invention was made to add Ananian's functionality for sending and converting a CAD file to the system and method of Cianfrocca to let users manipulate, modify, and update different CAD format files. One of ordinary skills in the art at the time the invention was made would have been motivated to do so, in order to improve interaction between the client and the professionals throughout the construction process; to ensure consistent and informed client input, cost-effective decisions, while maintaining the client's visionary perspective (Col. 2, lines 10 – 17, Ananian). In addition, the prior art suggests a successful outcome of this combination, such as, significantly reducing the time, complexity and uncertainty involved in the design of a structure (Col. 3, lines 43 – 45, Ananian), improving interaction between the client and the builder throughout the construction process (Col. 3, lines 53 – 55, Ananian), acquiring a fully detailed build specification from a client (Col. 3, lines 58 – 60, Ananian), and reducing lengthy communications between the builder and the client, making the builder efficient and able to focus on the core task: building the house (Col. 3, lines 61 – 64, Ananian).

⁴ Wherein the profile response corresponds to the requested file as claimed (Col. 3, lines 37 – 39, Ananian); the data file of the plan set corresponds to the requested file claimed (Col. 7, lines 9 – 13 and 20 – 24, Ananian); and the "XML" (External Markup Language) corresponds to the transmittal form claimed (Col. 7, lines 21 – 27 and 48 – 53, Ananian).

The combination of Cianfrocca in view of Ananian discloses all the limitations as discussed above including translating⁵ the content. However, the combination of Cianfrocca in view of Ananian does not expressly disclose: without content change of said requested file. On the other hand, Shapiro discloses converting files to formats without content change of said requested file (Fig. 5, and 6, “Source Artwork ENGLISH”, and “Target translated Artwork FRENCH”, Page 4, 5, and 6, [0051], [0067], and [0072], lines 1 – 20, 9 – 13, and 8 – 11, “... the Extractor adds an attribute whose value corresponds to the sequential identification number and which **does not cause a change to the appearance of the object in the Artwork file...**” (Emphasis added); and further “...when translating from one language to another, the size of print (point size) may need to decrease, or increase, **to preserve the same legibility of original text...**” (Emphasis added); respectively, Shapiro). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Shapiro’s teachings to the system of the combination of Cianfrocca in view of Ananian. Skilled artisan would have been motivated to do so, as suggested by Shapiro (Page 4, [0051], lines 1 – 9, Shapiro); and to efficiently transform location based objects, to convert geographical maps from one language to another, avoiding major re-editing of the source file, but keeping the appearance and quality of the location based translated text. In addition, both of the references (Cianfrocca, Ananian, and Shapiro) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, converting CAD data files, and translation.

⁵ According to the Academic Press Dictionary of Science and Technology (1992) from Elsevier Science &

This close relation between the applied references highly suggests an expectation of success.

Furthermore, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses:

and transmitting said requested file from said second database in said first transmittable format (Col. 20, lines 1 – 6, Ananian).

Regarding Claim 2, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a method, wherein said workstation is a CAD workstation (Col. 16, lines 24 – 28, Cianfrocca⁶; Col. 2, lines 43 – 47, Ananian) and said clearinghouse interface program is a plug-in application (Col. 16, lines 27 – 28, clients, Cianfrocca⁷; Col. 16, lines 26 – 29, Ananian).

Regarding Claim 3, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a method, wherein said establishing communications between said clearinghouse interface program and said clearinghouse server comprises authenticating and authorizing said clearinghouse interface program (Col. 13, lines 40 – 45, Ananian).

Technology, "translate" means: "1. To convert from one computer language to another. 2. Generally, to convert information from one form to another without altering meaning or function."

⁶ Cianfrocca discloses, as cited above, workstations including programs, in the User Agent, to communicate with the messenger system server (equivalent to the clearinghouse server). In addition, Cianfrocca discloses that the communication between the User Agent and messenger system server will be across firewall (Col. 8, lines 7 – 9). This implies that the workstations are also behind the firewall.

⁷ Cianfrocca discloses that clients will be programs that run at user workstations and call routines to connect to the messenger system server (equivalent to the clearinghouse server).

Regarding Claim 4, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a method, further comprising:

converting said requested file from said first transmittable format to a first CAD format (Col. 5, lines 21 – 28, Ananian);

translating said requested file from said first CAD format to a second CAD format (Col. 7, lines 8 – 12, Ananian; and Page 4, [0051], lines 14 – 20; Shapiro);

converting said requested file from said first CAD format to said second transmittable format (Col. 7, lines 49 – 54, Ananian);

transmitting said requested file to said first CAD station using said second transmittable format (Col. 7, lines 62 – 65, Ananian⁸); and

converting said requested file from said second transmittable format to said second CAD format (Col. 8, lines 6 – 11, Ananian⁹).

Regarding Claim 5, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a method, wherein said step of translating said requested file from said first CAD format to said second CAD format is performed by said clearinghouse server (Col. 6, lines 9 – 12, Ananian; and Page 4, [0051], lines 14 – 20; Shapiro).

⁸ The profile engine would correspond to the first CAD station.

⁹ The format of the extracted data with highly detailed features of the buildings corresponds to the Computer Aided Design (CAD) format.

Regarding Claim 6, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a method, wherein said first transmittable format comprises XML (Col. 7, lines 20 – 26, Ananian).

Regarding Claim 7, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a system for sharing files across disparate databases (Fig. 1, items 105, and 106, Col. 6, lines 11 – 20, Cianfrocca) comprising:

- a first server located behind a first firewall (Fig. 1, item 104, Col. 6, lines 13 – 14, Cianfrocca) and connected to a first database (Fig. 1, item 105, Col. 6, lines 11 – 14, Cianfrocca) that contains a first set of files (Col. 9, lines 40 – 43, Cianfrocca);

- a second server located behind a second firewall (Fig. 1, item 104, Col. 6, lines 14 – 17, Cianfrocca) and connected to a second database (Fig. 1, item 106, Col. 6, lines 14 – 17, Cianfrocca) that contains a second set of files (Col. 19, lines 30 – 33, application server components, Cianfrocca);

- a clearinghouse server (Fig. 1 and 4, item 103, Web Server Running Messenger System, Col. 6 and 17, lines 17 – 20 and 1 – 2; respectively, Cianfrocca) located outside of said first firewall and said second firewall (Fig. 1, item 104, Firewall, Col. 6, lines 19 – 22, Cianfrocca);

- a clearinghouse database located on said clearinghouse server (Fig. 4, Col. 17, line 54, Database, Cianfrocca) and having an index to at least a portion of said first set of files in said first database and at least a portion of said second set of files in said second database (Fig. 1, Col. 11, lines 4 – 8, Ananian);

a workstation located behind said first firewall (Col. 16, lines 24 – 28, Cianfrocca¹⁰) and having a clearinghouse interface program capable of interfacing with said clearinghouse database on said clearinghouse server (Col. 16, lines 24 – 28, messenger system enabled application components are programs that call routines in the User Agent Library, Cianfrocca¹¹), said clearinghouse interface program further capable of sending a request for a specific file indexed in said clearinghouse database (Col. 13, lines 14 – 26, Ananian);

said clearinghouse server further receiving said request for said specific file from said workstation (Col. 13, lines 29 – 30, Ananian), determines that said specific file is located on said second database (Col. 14, lines 2 – 4, Ananian¹²), and sends said request for said specific file to said second server (Col. 14, lines 35 – 38, Ananian); and

said second server further receives said request for said specific file (Col. 7, lines 39 – 41, Ananian), locates said specific file in said second database (Col. 7, lines 65 – 67, Ananian), converts said specific file into a first transmittable format (Col. 8, lines 4 – 10, Ananian) without content change of said specific file (Fig. 5, and 6, “Source Artwork ENGLISH”, and “Target translated Artwork FRENCH”, Page 4, 5, and 6, [0051], [0067], and [0072], lines 1 – 20, 9 – 13, and 8 – 11, “... the Extractor adds an attribute whose value corresponds to the sequential identification number and which **does not cause a**

¹⁰ Cianfrocca discloses, as cited above, workstations including programs, in the User Agent, to communicate with the messenger system server (equivalent to the clearinghouse server). In addition, Cianfrocca discloses that the communication between the User Agent and messenger system server will be across firewall (Col. 8, lines 7 – 9). This implies that the workstations are also behind the firewall.

¹¹ Cianfrocca further discloses that these components run in workstations with an interface (Col. 16, lines 27 – 28).

¹² Ananian further discloses entering zip code or country (location) and other topics of the specific item requested. This implies locating the requested item in a specific database (see Col. 14, Table 1, lines 23 and 27).

change to the appearance of the object in the Artwork file...” (Emphasis added); and further “...when translating from one language to another, the size of print (point size) may need to decrease, or increase, **to preserve the same legibility of original text...**” (Emphasis added); respectively, Shapiro), and sends said specific file (Col. 20, lines 1 – 6, Ananian).

Regarding Claim 8, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a system, wherein said first database contains files in a first CAD format (Col. 2, lines 43 – 47, Ananian) and said second database contains files in a second CAD format (Col. 8, lines 54 – 57, Ananian¹³).

Regarding Claim 9, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses system, wherein said clearinghouse server is further adapted to:

receive said specific file (Col. 5, lines 52 – 57, Ananian);

convert said specific file from said first transmittable format to said second CAD format (Col. 6, lines 4 – 6, Ananian¹⁴);

translate said specific file from said second CAD format to said first CAD format (Col. 6, lines 10 – 13, Ananian; and Page 4, [0051], lines 14 – 20; Shapiro);

¹³ The CAD files that are manipulated by the system were sent to and obtained from the builders' database.

¹⁴ Standardized data set (protocol) is a CAD format file (Col. 7, line 12, Ananian).

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convert said specific file from said first CAD format into a second transmittable format (Col. 6, lines 25 – 28, Ananian); and

transmit said specific file to said workstation (Col. 13, lines 34 – 36, Ananian).

Regarding Claim 10, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a system, wherein said clearinghouse interface program comprises a plug-in application (Col. 16, lines 26 – 29, Ananian).

Regarding Claim 11, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses a system, wherein said first transmittable format comprises XML (Col. 7, lines 20 – 26, Ananian).

(10) Response to Argument

The issue presented for appeal are whether claims 1 – 11 are patentable under 35 U.S.C. 103(a) over Cianfrocca et al. (U.S. Patent No. 6,088,796) in view of Ananian et al. (U.S. Patent No. 6,922,701), and further in view of Shapiro (U.S. Patent Application Publication No. 2006/0005126 A1, filed on October 7, 2002).

A and B: Rejection of claims 1 and 7

Appellant appears to argue that the applied art fails to disclose the claimed limitation: “converting...without content change of said requested file.”

Examiner respectfully disagrees. As stated in the Office Action dated November 20, 2006, the combination of Cianfrocca in view of Ananian discloses all the limitations as discussed above including translating the content (Col. 5, lines 29 – 30, “The analog plans can first be scanned at a resolution sufficient to ensure accurate data translation of the plan set.”, Col. 6, lines 25 – 28, “ The profiling engine 30 of the present invention can translate the complex graphical and engineering information within AEC/CAD files to the user-friendly format of the enhanced profile database...”, Ananian). The Examiner submits that: according to the Academic Press Dictionary of Science and Technology (1992) from Elsevier Science & Technology, “translate” means: “1. To convert from one computer language to another. 2. Generally, to convert information from one form to another without altering meaning or function.”. However, the

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combination of Cianfrocca in view of Ananian does not expressly disclose: without content change of said requested file. Therefore, the Examiner presented the third reference Shapiro which discloses converting files to formats without content change of said requested file (See 103 rejection of claims 1, and 7, as discussed in this Office Action above, Page 6). Specifically, Shapiro discloses the limitation: “without content change” (Fig. 5, and 6, “Source Artwork ENGLISH”, and “Target translated Artwork FRENCH”, Page 4, 5, and 6, [0051], [0067], and [0072], lines 1 – 20, 9 – 13, and 8 – 11, “... the Extractor adds an attribute whose value corresponds to the sequential identification number and which **does not cause a change to the appearance of the object in the Artwork file**...” (Emphasis added); and further “...when translating from one language to another, the size of print (point size) may need to decrease, or increase, **to preserve the same legibility of original text**...” (Emphasis added); respectively, Shapiro).

Additionally, appellant’s specification also describes the limitation as translating (See for example: [0025], [0029], [0032], [0035], specification of the disclosure).

C: Rejection of claims 2-6, and 8 - 11

Appellant's arguments directed towards the rejection of claims 2-6, and 8-11 reiterate deficiencies Appellant feels were made in the rejection of the independent claims, and do not address any new points. Therefore, the examiner submits that if the rejection of the independent claims is deemed proper, the rejection of claims 2-6, and 8-11 should also be upheld.

D: Appellant's arguments based on examiner's response to arguments

Appellants states that: "In the Response to Arguments beginning on page 13 of the Office Action date May 14, 2007, the Examiner stated in part that: 'In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features of claims 1 and 7 upon which applicant relies (i.e., 'the user is sent a requested file converted into transmittable form'; and that the claims as earlier amended require that; 'the content of said files remains unaltered') are not recited in such rejected claims... .' Since this latter limitation was specifically added to claims 1 and 7 by Preliminary Amendment dated October 11, 2006, appellants fail to understand what the Examiner means by this statement."

Examiner respectfully disagrees. The specific limitations: "**the user is** sent a requested file converted into transmittable form" and "the content of said files remains unaltered" are not currently recited in the claims and/or were added by the Amendment dated October 11, 2006. As stated by the Examiner in the Final Office Action, although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that; “Shapiro teaches away from the present claimed invention, appellants believe the Examiner has improperly combined Shapiro with Cianfrocca et al. and Ananian.”

Examiner respectfully disagrees. As stated in Final Office Action dated May 14, 2007, the combination of Cianfrocca in view of Ananian discloses translating (Col. 5, lines 29 – 30, “The analog plans can first be scanned at a resolution sufficient to ensure accurate data translation of the plan set.”, Col. 6, lines 25 – 28, “ The profiling engine 30 of the present invention can translate the complex graphical and engineering information within AEC/CAD files to the user-friendly format of the enhanced profile database...”, Ananian). Examiner included the Shapiro reference, since it teaches also translating (specifically, by converting without content change of the file). In addition, a skilled artisan would have been motivated to make such combination, to convert geographical maps from one language to another, avoiding major re-editing of the source file, but keeping the appearance and quality of the location based translated text (See: Page 4, [0051], lines 1 – 9, Shapiro).

Also, the examiner notes that the references do not criticize, discredit, or otherwise discourage the solution claimed. Appellant should duly note that; “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away

from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Therefore, the combination of Cianfrocca in view of Ananian and further in view of Shapiro is proper.

Appellant argues that; “Motivation For The Combination of Cianfrocca And Ananian with Shapiro Is Lacking.”

Examiner respectfully disagrees. The prior art discloses a motivation for combining the references. As suggested by Shapiro (See: Page 4, [0051], lines 1 – 9, Shapiro), skilled artisan would have been motivated to make such combination, to convert geographical maps from one language to another, avoiding major re-editing of the source file, but keeping the appearance and quality of the location based translated text. **Second**, there must be a reasonable expectation of success. The prior art suggests a successful outcome of this combination, such as, keeping the appearance and quality of the location based translated text. **Third**, the applied references (Cianfrocca in view of Ananian and further in view of Shapiro) teach features that are directed to the same industry field of database management systems, such as, converting CAD data files, and translation. This close relation between the applied references highly suggests an expectation of success. Finally, the combination of Cianfrocca in view of Ananian and further in view of Shapiro discloses all the claim

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limitations disclosed in the claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Giovanna Colan/

Examiner, Art Unit 2162

Conferees:

/John Breene/

Supervisory Patent Examiner, Art Unit 2162

/Eddie C Lee/

Supervisory Patent Examiner, TC 2100

Eddie C. Lee
TQAS/Appeals Specialist
TC 2100

An appeal conference was held on 21 April, 2008, and it was agreed to proceed to the board of appeals.